

### **REMARKS/ARGUMENTS**

Claims 4-7 are pending in the present application and are all presently rejected. New claim 7 has been added in this response. No new matter has been introduced. Applicants request reconsideration of the rejections in light of the following remarks.

Claims 4-6 of were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rogers* (U.S. Pat. No. 5,617,471) in view of *Shaffer* (U.S. Pat. No. 5,825,858), further in view of *Curtis et al.* (US Patent 6,614,897). The Applicants respectfully traverse this rejection for the following reasons.

Concerning independent claims 4 and 7, the prior art, alone or in combination, fails to teach the claimed element of “initiating setup, via the telecommunications switching office, and after reception of a request originating from the one of the further subscriber line and the operator’s position, of a new direct telecommunications connection between the two subscriber lines wherein the telecommunications switching office requests one of two further telecommunications switching offices to which the two subscriber lines are respectively connected to set up the new telecommunications connection.”

As was conceded in the Office Action (page 4), neither *Rogers* nor *Shaffer* disclose these features. Regarding *Curtis*, the reference teaches a call transfer between a first calling party *A* and a called party *C* over a network switch, managed by an intelligent network using a manual operator of a service provider. *Curtis* further discloses that the initial call from party *A* to the service provider may be made via the Internet, with only the final connection between *A* and *C* being made via the PSTN (col. 5, lines 49-67). Although the service provider (i.e., manual operator) can be removed, *Curtis* is completely silent on whether the network switch between the service provider and the two parties *A* and *C* is also completely released/removed by changing the routing from Internet to PSTN. Throughout the entire disclosure, *Curtis* does not have a physical connection between parties *A* and *C* that is rerouted without passing through the network switch. This is similar to the teaching in *Rogers*, which teaches that a call between the two connected users always remains connected only to switch *A*, and does not involve other respective switches as required in the present claims. Accordingly, *Curtis* does not teach the feature “wherein the telecommunications switching office requests one of two further telecommunications switching offices to which the two subscriber lines are respectively

connected to set up the new telecommunications connection.” For at least these reasons, Applicants submit that the rejection is improper and should be withdrawn.

Furthermore, Applicants maintain that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Rogers* and *Shaffer* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such

that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

It has been conceded that *Rogers* does not teach or suggest the claimed feature of “set[ting] up the new telecommunications connection in accordance with a selection which is made as a function of a tariff model which forms a basis of a billing system.” In *Rogers*, a billing system is already disclosed, where a network call identifier uniquely identifies the call which is currently active or completed. Call detail records appear for call legs A-B 3, A-C 5, and B-C 7 on the customers' reports that accompany the invoices, so that the customers can readily identify the transferred calls (col. 7, line 65 – col. 8, line 24). In contrast, *Shaffer* relies on a unique conference bridge, utilizing a conference bridge manager that interfaces with the user interface, a connectivity computation component and a message interface component to tie in remote conference bridges (col. 4, lines 5-13; 30-39). As *Rogers* already provides for its own automated billing mechanism, there is no conceivable teaching, suggestion or motivation, other than one that was improperly gleaned from Applicant's disclosure, why one skilled in the art would turn to *Shaffer* to incorporate the conference bridge disclosed therein.

This matter remains unaddressed in any of the Office Actions. While *Shaffer* discloses “optimal” routing for nodes within a conference bridge, *Shaffer* does not disclose the features discussed above, and no teaching suggestion or motivation was provided, other than to “automate teleconferencing” while “saving money.” As *Rogers* already provides automated call-transfer with an integrated billing system, there is no teaching to combine the references in the manner suggested in the office action.

Concerning dependent claims 5 and 6, these claims are believed allowable on their merits and also on their dependency on claim 4.

In light of the above, the Applicants respectfully submit that claims 4-7 of the present application are patentable over the art of record. Therefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Appl. No. 09/979,532

Reply to Office Action dated September 2, 2005

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

A handwritten signature in black ink, appearing to read "Peter Zura", is written over a horizontal line.

Peter Zura

Reg. No. 48,196

Customer No.: 29177

(312) 807-4208

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